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Applicant: James B. Riley
Serial No.: 09/637,388

REMARKS/ARGUMENTS

Claims 70-81 were pending in the present application. Claims 72, 76 and 80 have been cancelled and independent claims 70, 74 and 78 have been amended to more particularly point out and distinctly claim Applicants' invention. Support for the amendments can be found in the specification as originally filed at page 13, lines 12-20. Claims 70, 71, 73-75, 77-79 and 81 are currently before the Examiner for consideration. The Examiner's withdrawal of the § 102 rejection of claims 73, 77 and 81 as being anticipated by Gupta et al. (U.S. Publication No. 2003/0196164) (hereinafter "Gupta") is gratefully acknowledged. It is hoped that the amendments and accompanying response place the application in condition for allowance.

35 U.S.C. § 112, 1st Para.

The Examiner has rejected claims 73, 77 and 81 under 35 U.S.C. § 112, first paragraph, for containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants respectfully disagree.

The Examiner states that the limitation "prohibiting access to the at least one document after completion of the interactive learning course" of claims 73, 77 and 81 does not have support in the specification as originally filed. As stated in the Request for Continued Examination filed June 13, 2005, support for this limitation can be found in original claim 16 and in the specification at page 12, line 31 through page 13, line 3. In particular, the specification reads "in some embodiments, however, a user may be able to store a version of the notes at his or her location. This enables the user to copy and access the notes when *not using* the original document or course" (emphasis added). Verbatim wording of claim language is not required. See M.P.E.P. § 2163 I (B), 2nd para. ("While there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure.").

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"Prohibiting access" is encompassed by the specification's broader phrase "not using." The phrase "not using" addresses both intermittent periods of non-use based on user discretion as well as continual periods of non-use based on the course provider's discretion. For example, a user may not be using the course because they no longer have access (i.e., the course timeline is complete and access is now prohibited). On the other hand, a user may "not (be) using" the course because they have downloaded their notes and, perhaps due to a summer thunderstorm, cannot access the course due to internet issues. Maybe a user has chosen to use just their notes to review for a test. The broad term "not using" clearly encompasses "prohibiting access," as well as a number of other scenarios.

In the recent case of *Phillips v. AWH Corp.*, Nos. 03-1269, 03-1286, 2005 WL 1620331, at *1 (Fed. Cir. July 12, 2005) (en banc), the Federal Circuit clarified in great detail the proper procedure for construing claims of a patent (or application). During its discourse, the Court emphasized the importance of the specification in the claim construction process, noting that "the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but [also] in the context of the entire patent, including the specification." *Id.* at *5. Thus, claim construction must not be done in a vacuum, but rather must be reasonable in view of the patent specification and prosecution history. See *Medrad, Inc. v. MRI Devices Corp.*, 401 F.3d 1313, 1319 (Fed. Cir. 2005); see also *Kinik Co. v. Int'l Trade Comm'n*, 362 F.3d 1359, 1365 (Fed. Cir. 2004) ("The words of patent claims have the meaning and scope with which they are used in the specification and the prosecution history"). As the Federal Circuit explained, "[t]he claims, of course, do not stand alone. Rather, they are part of 'a fully integrated written instrument, . . . , consisting principally of a specification that concludes with claims. For that reason, claims 'must be read in view of the specification, of which they are part'." *Phillips*, 2005 WL 1620331, at *7 (internal citations omitted). Thus, in performing his analysis of the claims of the present application, the Examiner must not only rely upon the claim language, but must instead give the claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *Id.* at *9 (citing *In re Am. Acad. of Sci. Tech. Ctr.*,

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367 F.3d 1359, 1364 (Fed. Cir. 2004)). As noted above, one of ordinary skill in the art would look to the specification to understand the selected claim language without specifically importing limitations from the specification into the claims. *See id.* at *16.

Applying the foregoing law to the instant case, it is clear from the context of Applicants' specification (see specification, page 1, lines 8-11; page 2, lines 26 through page 5, line 6; page 5, line 23 through page 6, line 3) that "prohibiting access ... after completion of the online learning course" as recited in Applicants' claims simply refers to the point in the educational cycle in which the student no longer has access to and is not using the course materials, whether that be during test taking or further along in time when notes may be reviewed to refresh a previously learned, but forgotten point, such as trigonometry. The entire focus of Applicants' invention, as set forth in the specification, is on the ability to take notes during online courses. Online courses, like traditional courses, are not accessible forever. This well-known fact is alluded to in the specification at page 3, lines 6-9: "For example, a general course of instruction may be presented to an individual *after which* the computer may query the individual regarding the principles just learned" (emphasis added). *See also*, page 3, lines 31-34: "Computer programs designed to aid in the learning process typically first present a section of the information and then test the individual based on the information presented." The Examiner also presents Applicants' current point at page 9 of the most recent Office Action, wherein the Examiner states that "it is well known in the educational arts that testing is traditionally undertaken after completion of the learning course in a 'closed book' environment, where access to the learning material [as well as class notes] is prohibited." Based on all of the above, Applicants contend that the specification as originally filed inherently supports the claim limitation at issue and that this rejection should therefore be withdrawn.

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35 U.S.C. § 112, 2nd Para.

The Examiner has also rejected claims 73, 77 and 81 under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which applicants regards as his invention. Once again, Applicants respectfully disagree.

The Examiner states that the term "prohibiting access" is relative and therefore renders the claims indefinite. In particular, the Examiner states that the term is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. Applicants do not expressly define the terms "prohibiting" or "access" in the specification. Therefore, the terms must be given their plain meaning. See M.P.E.P. § 2111.01. Dictionary.com defines "prohibiting" as preventing or precluding. See Appendix 1. Dictionary.com defines "access" as "the ability or right to ... make use of." See Appendix 2. Based on these definitions, the term "prohibiting access" means exactly what it says, namely, that the right to use at least one document of an interactive learning course is prevented *after completion* of the course. The term "prohibiting access" is not a relative term because the meaning is readily apparent. As discussed above with respect to the 112, 1st rejection, this phenomenon is well known in traditional learning institutions. The term does not contain any degree. Either the student has access to the course or doesn't. Therefore, Applicants respectfully request that the present rejection be withdrawn.

35 U.S.C. § 102

The Examiner has rejected claims 70-72, 74-76 and 78-80 as being anticipated by Gupta. Based on the amendments to claims 70, 74 and 78 submitted herewith, Applicants respectfully disagree.

The Examiner alleges that Gupta meets the limitation of Applicants' claim that reads "providing access to the entered notes after completion of the interactive learning course." In

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particular, the Examiner asserts that this limitation is met at Gupta page 1, para. 6, which states that "some systems allow a user to select a particular one of these annotations and begin playback of the presentation starting at approximately the point in the presentation to which the annotation corresponds." By the amendments presented herewith, that limitation of Applicants' claims now reads "limiting subsequent access to the entered notes to the user only." Gupta does not disclose the amended limitation because the whole purpose of Gupta is to share the annotations on computers having different speeds. See abstract, paras. 0006, 0008, 0011, 0012, 0062, 0070, 0077, 0090, 0091, 0097-0100, 0104, 0111, 0115-0117 and 0119. While Gupta permits users to target to whom they send their notes (see para. 0090), Gupta requires that the notes be directed to another user ("According to one embodiment, ... allowing the creator of the set to identify which users are able to read and/or write to the annotation set"). Therefore, Gupta clearly fails to disclose limiting access only to the author of the notes as now recited in claims 70, 74 and 78.

To anticipate a claim, the reference must teach every element of the claim. M.P.E.P. § 2131. The Examiner is permitted to give claims their broadest reasonable interpretation. M.P.E.P. § 2111. However, this interpretation must be reasonable. See *id.* citing *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999) (The Board's construction of the claim limitation "restore hair growth" as requiring the hair to be returned to its original state was held to be an incorrect interpretation of the limitation. The court held that, consistent with Applicants' disclosure and the disclosure of three patents from analogous arts using the same phrase to require only some increase in hair growth, one of ordinary skill would construe "restore hair growth" to mean that the claimed method increases the amount of hair grown on the scalp, but does not necessarily produce a full head of hair.).

Because claims 70, 74 and 78 allow the only user to access the notes, the present rejection is not proper and should be withdrawn. Therefore, Applicant respectfully requests that claims 70, 74 and 78 be passed to allowance.

Claims 71, 75 and 79 are dependent upon claims 70, 74 and 78, which claims have been shown allowable above. Therefore, at least because claims 71, 75 and 79 each introduce additional

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subject matter that, when considered in the context of the recitations of their respective base claims, constitutes patentable subject matter, Applicant respectfully submits that the recitations of claims 71, 75 and 79 are not disclosed or suggested by Gupta. Therefore, Applicant respectfully submits that claims 71, 75 and 79 are in proper condition for allowance.

35 U.S.C. § 103

The Examiner rejected claims 73, 77 and 81 under 35 U.S.C. § 103(a) as being unpatentable over Gupta in view of Bohlen et al., "The effect of Learning Style and Method of Instruction on the Achievement, Efficiency and Satisfaction of End-Users Learning Computer Software," published in 1993 on the Internet by ACM (hereinafter "Bohlen"). For the reasons provided below, Applicant respectfully disagrees.

To provide a prima facie case of obviousness, three basic criteria must be met. M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The Examiner concedes that Gupta fails to explicitly describe controls for the learning material. The Examiner provides Bohlen to support the proposition that access to learning course material is prohibited during testing. It is interesting to note that Bohlen does not teach this proposition anywhere in the article. However, even if Bohlen did teach this proposition, there is no motivation to combine the teachings of Gupta and Bohlen. The Examiner has utilized Applicants' claims to find elements available in the prior art to render Applicants' invention obvious. However, the mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See M.P.E.P. § 2143.01 (III) (emphasis in original).

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Unfortunately, even if the Examiner's motivation was proper, the resulting statement does not render Applicants' current claims obvious because the amended claims do not limit access to the user only. This limitation on access is contrary to the Gupta's purpose, which provides for the ability to share notes even though each user's computer has different computing ability. Therefore, the current rejection should be withdrawn and the claims passed to allowance.

In addition, claims 73, 77 and 81 are dependent upon claims 70, 74 and 78, which claims have been shown allowable above. Therefore, at least because claims 73, 77 and 81 each introduce additional subject matter that, when considered in the context of the recitations of their respective base claims, constitutes patentable subject matter, Applicant respectfully submits that the recitations of claims 73, 77 and 81 are not obvious in view of Gupta and Bohlen. Therefore, Applicant respectfully submits that claims 73, 77 and 81 are in proper condition for allowance.

Applicants have responded to all of the Examiner's rejections. Reconsideration and allowance are respectfully requested.

The Examiner is invited to contact the undersigned by telephone, facsimile or email if the Examiner believes that such a communication would advance the prosecution of the instant application. Please charge any necessary fees associated herewith, including extension of time fees (if applicable and not paid by separate check), to the undersigned's Deposit Account No. 50-1111.

Sincerely,

Date: 5.17.06

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